

TO: **Mail Stop 8**
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**REPORT ON THE
FILING OR DETERMINATION OF AN
ACTION REGARDING A PATENT OR
TRADEMARK**

In Compliance with 35 § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court Northern District of California on the following Patents or Trademarks:

DOCKET NO. CV 11-04100 PSG	DATE FILED 8/19/2011	U.S. DISTRICT COURT 280 South First Street, Rm 2112, San Jose, CA 95113
PLAINTIFF TESSENDERLO KERLEY INC		DEFENDANT OR-CAL INC
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1 <i>6,110,867</i>		SEE ATTACHED COMPLAINT
2 <i>6,464,995</i>		
3		
4		
5		

In the above—entitled case, the following patent(s) have been included:

DATE INCLUDED	INCLUDED BY	<input type="checkbox"/> Amendment <input type="checkbox"/> Answer <input type="checkbox"/> Cross Bill <input type="checkbox"/> Other Pleading
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
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In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT		
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CLERK Richard W. Wierking	(BY) DEPUTY CLERK Betty Walton	DATE August 23, 2011
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Copy 1—Upon initiation of action, mail this copy to Commissioner Copy 3—Upon termination of action, mail this copy to Commissioner
Copy 2—Upon filing document adding patent(s), mail this copy to Commissioner Copy 4—Case file copy

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Att. 3 201

12 **UNITED STATES DISTRICT COURT FOR THE**
13 **NORTHERN DISTRICT OF CALIFORNIA**

PSG

16 TESSENDERLO KERLEY, INC., a
17 Delaware corporation,

CV 11 4100

Case No.

18 Plaintiff,
19 v.
20 OR-CAL, Inc., an Oregon corporation,
21 Defendant.

COMPLAINT FOR
PATENT INFRINGEMENT

DEMAND FOR JURY TRIAL

1 Plaintiff Tessenderlo Kerley, Inc. (“TKI”), by and through its undersigned attorneys, files
2 this Complaint against defendant OR-CAL, Inc. (“OR-CAL”). In support of its claims, TKI
3 states as follows:

4 **PARTIES**

5 1. TKI is a Delaware corporation having its principal place of business at 2255
6 North 44th Street, Phoenix, Arizona 85008.

7 2. Upon information and belief, defendant OR-CAL is an Oregon corporation,
8 having a principal place of business at 29454 Meadowview Road, Junction City, Oregon
9 97448.

10 3. Defendant OR-CAL manufactures and distributes crop protectants throughout
11 the United States, including in the state of California, in direct competition with TKI.

12 **JURISDICTION AND VENUE**

13 4. This is an action for patent infringement arising under the Patent Act.

14 5. This Court has subject matter jurisdiction over this action under 28 U.S.C. §
15 1338(a), which confers jurisdiction over cases of patent infringement, and under 28 U.S.C. §
16 1331, which confers federal question jurisdiction in general.

17 6. Venue is proper in this district pursuant to 28 U.S.C. §§ 1391 and 1400.

18 **INTRADISTRICT ASSIGNMENT**

19 7. This is an Intellectual Property Action to be assigned on a district-wide basis
20 pursuant to Civil Local Rule 3-2(c).

21 **NATURE OF THE ACTION**

22 8. This action is brought under the Patent Act, 35 U.S.C. § 271 *et seq.*

23 9. TKI seeks injunctive and compensatory damages for OR-CAL’s willful
24 infringement of TKI’s United States Patent Nos. 6,110,867 (“the ‘867 patent”) and 6,464,995
25 (“the ‘995 patent”).

26 10. TKI and OR-CAL are direct competitors in the market for the manufacture and
27 sale of crop protectants.

28 11. OR-CAL’s patent infringement has resulted in substantial harm to TKI in the

1 form of lost sales and lost profits. Injunctive relief from this Court is necessary to prevent
2 further harm to TKI.

3 **BACKGROUND**

4 **TKI's Patents**

5 12. The '867 patent, entitled "Method for Providing Enhanced Photosynthesis,"
6 issued on August 29, 2000 in the name of inventors David Michael Glenn, Dennis G.
7 Sekutowski, and Gary J. Puterka. TKI enjoys all exclusive rights and privileges with respect
8 to the '867 patent in the United States, including the right to enforce the '867 patent in its
9 own name. A copy of the '867 patent is attached hereto as Exhibit 1.

10 13. The '867 patent was the subject of reexamination proceedings, Application
11 Serial No. 90/006,658, before the United States Patent and Trademark Office ("USPTO"). A
12 reexamination certificate was issued by the USPTO on March 7, 2006.

13 14. The subject matter of the '867 patent relates to a method for enhancing
14 photosynthesis of a horticultural crop by increasing carbon dioxide assimilation of said
15 horticultural crop which comprises applying to the surface of said horticultural crop an
16 effective amount of one or more highly reflective particulate materials, said particulate
17 materials being finely divided, and wherein the particles as applied allow for the exchange of
18 gases on the surface of said crop and the finely divided particulate materials have a median
19 individual particle size below about 3 microns.

20 15. The '995 patent, entitled "Treated Horticultural Substrates," issued on October
21 15, 2002 in the name of inventors Dennis G. Sekutowski, and Gary J. Puterka, and David
22 Michael Glenn. TKI enjoys all exclusive rights and privileges with respect to the '995 patent
23 in the United States, including the right to enforce the '995 patent in its own name. A copy
24 of the '995 patent is attached hereto as Exhibit 2.

25 16. The subject matter of the '995 patent relates to a method for enhancing the
26 horticultural effect of horticultural substrates selected from the group consisting of fruits,
27 vegetables, trees, flowers, grasses, roots, and landscape and ornamental plants which
28 comprises applying a slurry comprising water, a surfactant, and one or more particulate

materials, selected from the group consisting of calcium carbonate, hydrous kaolin, calcined kaolin and mixtures thereof, to the surface of said substrate to form a membrane comprised of one or more particulate layers and the surfactant, said layers comprising one or more particulate materials, said particulate materials being finely divided, and wherein said membrane allows for the exchange of gases on the surface of said substrate.

Crop Protectant Products

17. TKI manufactures and sells a kaolin-based crop protectant product under the brand name Surround®, for use as a broad spectrum agricultural crop protectant for controlling damage from various physiological disorders such as sunburn and heat stress as well as a growth enhancer. Exhibit 3 (Surround label). TKI has the right to exclude from the marketplace any competing product for which its application infringes at least claim 1 of the '867 patent and/or claim 23 of the '995 patent.

18. On information and belief, OR-CAL has manufactured, offered for sale, and/or sold calcium carbonate sun protectant products for crops, including products ultimately distributed as Mask® and/or Diffusion®.

19. The Mask and/or Diffusion sunburn protectant products have been and/or are distributed by Wilbur-Ellis Company, which has its Corporate and Agribusiness offices in this judicial district, respectively at 345 California Street, San Francisco, California 94104 and 1801 Oakland Boulevard, Walnut Creek, California 94596. *See Exhibit 4 (Mask label) and Exhibit 5 (Diffusion label).* On information and belief, the Mask and/or Diffusion products have been and/or are manufactured and packaged by defendant OR-CAL and sold to Wilbur-Ellis Company which in-turn offers for sale, sells, and has sold these products to others.

OR-CAL's Infringement of TKI's Patents

20. Upon information and belief, application of OR-CAL's calcium carbonate products, such as the Mask and/or Diffusion products, infringes at least claim 1 of the '867 patent and claim 23 of the '995 patent. Promotional materials for the Mask and Diffusion products describes them as: (1) a flowable micronized dispersion of calcium carbonate, (2)

1 recommended as a protectant against, and used in minimizing, sunburn and heat stress; (3)
2 optimizing and allowing for greater photosynthesis; and/or (4) providing a healthy crop and
3 the best yields. *See, e.g.*, Exhibits 4, 5, and 6 (brochure entitled "Diffusion. The Science of
4 Light Management.").

5 **COUNT I**

6 **Infringement of U.S. Patent No. 6,110,867**

7 21. Paragraphs 1 through 20 of the complaint are incorporated by reference as
8 though fully set forth herein.

9 22. All claims of the '867 patent are presumed valid and enforceable.

10 23. On information and belief, defendant OR-CAL has contributorily infringed
11 and/or actively induced the infringement under 35 U.S.C. § 271, and continues to
12 contributorily infringe and/or actively induce the infringement under 35 U.S.C. § 271, of at
13 least claim 1 of the '867 patent by (1) making, having made, selling, and/or offering for sale,
14 (2) authorizing others to make, have made, sell, and/or offer for sale, and/or (3) causing
15 others to use calcium carbonate products such as the Mask and/or Diffusion products.

16 24. Defendant OR-CAL's infringement is committed with knowledge of the '867
17 patent and is intentional, willful and deliberate.

18 25. As a result of defendant OR-CAL's infringement of the '867 patent, TKI has
19 been damaged and will be further damaged, and is entitled to be compensated for such
20 damages, pursuant to 35 U.S.C. § 284, in an amount to be determined at trial.

21 26. As a result of defendant OR-CAL's infringement of the '867 patent, TKI has
22 suffered and will continue to suffer irreparable harm, for which TKI has no adequate remedy
23 at law, unless the Court enjoins such infringing activities pursuant to 35 U.S.C. § 283.

24 **COUNT II**

25 **Infringement of U.S. Patent No. 6,464,995**

26 27. Paragraphs 1 through 26 of the complaint are incorporated by reference as
27 though fully set forth herein.

28 28. All claims of the '995 patent are presumed valid and enforceable.

29. On information and belief, defendant OR-CAL has contributorily infringed and/or actively induced the infringement under 35 U.S.C. § 271, and continues to contributorily infringe and/or actively induce the infringement under 35 U.S.C. § 271, of at least claim 23 of the '995 patent by (1) making, having made, selling, and/or offering for sale, (2) authorizing others to make, have made, sell, and/or offer for sale, and/or (3) causing others to use calcium carbonate products such as the Mask and/or Diffusion products.

30. Defendant OR-CAL's infringement is committed with knowledge of the '995 patent and is intentional, willful and deliberate.

31. As a result of defendant OR-CAL's infringement of the '995 patent, TKI has been damaged and will be further damaged, and is entitled to be compensated for such damages, pursuant to 35 U.S.C. § 284, in an amount to be determined at trial.

32. As a result of defendant OR-CAL's infringement of the '995 patent, TKI has suffered and will continue to suffer irreparable harm, for which TKI has no adequate remedy at law, unless the Court enjoins such infringing activities pursuant to 35 U.S.C. § 283.

REQUEST FOR RELIEF

WHEREFORE, TKI respectfully requests that this Court enter a Judgment and Order in its favor and against defendant OR-CAL as follows:

(a) A judgment that defendant OR-CAL has contributed to and/or actively induced the infringement of the '867 patent by (i) making, having made, selling, and/or offering for sale, (ii) authorizing others to make, have made, sell, and/or offer for sale, and/or (iii) causing others to use calcium carbonate products such as the Mask and/or Diffusion products in the United States;

(b) A judgment that defendant OR-CAL has contributed to and/or actively induced the infringement of the '995 patent by (i) making, having made, selling, and/or offering for sale, (ii) authorizing others to make, have made, sell, and/or offer for sale, and/or (iii) causing others to use calcium carbonate products such as the Mask and/or Diffusion products in the United States:

(c) A judgment and order permanently enjoining defendant OR-CAL from further

1 infringing the '867 patent by (i) making, having made, selling, and/or offering for sale, (ii)
2 authorizing others to make, have made, sell, and/or offer for sale, and/or (iii) causing others
3 to use calcium carbonate products such as the Mask and/or Diffusion products in the United
4 States;

5 (d) A judgment and order permanently enjoining defendant OR-CAL from further
6 infringing the '995 patent by (i) making, having made, selling, and/or offering for sale, (ii)
7 authorizing others to make, have made, sell, and/or offer for sale, and/or (iii) causing others
8 to use calcium carbonate products such as the Mask and/or Diffusion products in the United
9 States;

10 (e) A judgment and order requiring defendant OR-CAL to pay all available and
11 legally permissible damages to compensate TKI for defendant's infringing acts, but in no
12 event less than a reasonable royalty in accordance with 35 U.S.C. § 284;

13 (f) A finding that defendant's conduct is willful, warranting an award of treble
14 damages under 35 U.S.C. § 284;

15 (g) A finding that this case is exceptional under 35 U.S.C. § 285, warranting an
16 award to TKI of its costs, including attorney fees, and other expenses incurred in connection
17 with this action;

18 (h) A judgment and order requiring that defendant OR-CAL pay TKI pre-
19 judgment interest and post-judgment interest on all damages awarded;

20 (i) Such further relief as this Court deems just and appropriate.

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JURY DEMAND

TKI demands a trial by jury on all issues so triable.

STEPTOE & JOHNSON LLP

Dated: August 18, 2011

By:

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